

III. REMARKS

The Examiner is requested to reconsider the application in view of the foregoing amendment, to tidy up the claims, and the following remarks. It is believed that no new matter has been added.

At the outset, the Examiner's attention is drawn to Applicant's co-pending application Ser. No. 10/867,520, which the Examiner is also handling. Consideration should be given to provisional double patenting, and if such a rejection is made in a non-provisional way, Applicant will respond thereafter.

Respectfully, and generally for the reasons set forth below, the Election/Restriction requirement, and each ground therefor, are traversed to the extent that they are not rendered moot by the foregoing amendment.

In the Office Action, a Restriction Requirement has been made pursuant to 35 U.S.C. Sec. 121 and pursuant to 35 U.S.C. Sec. 372. The Examiner contends that the groups of inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1, and that in accordance with 37 C.F.R. 1.499, Applicant is required to elect a single invention to which the claims must be restricted.

In response, Applicant elects Group I (claims 1-16) with traverse, for the reasons set forth below.

First, with respect to the Restriction Requirement made pursuant to 35 U.S.C. Sec. 121, this statute requires a showing of "separate and distinct." The Restriction Requirement made under the Office Action under Sec. 121 is defective for failing to even allege "separate and distinct" There is no allegation of having "separate utility." There is no showing of any of these in the Office Action. Nor does the Office Action set out a showing of any burden on the Examiner. Thus, the Examiner has not made out a *prima facie* case for Restriction under Sec.

121. Indeed, the Restriction Requirement is defective for noncompliance with MPEP Sec. 806.05(d), which requires "restriction is only proper when there would be a serious burden if restriction were not required, as evidenced by separate classification, status, or field of search." The Restriction Requirement fails to even set out the class and subclass, and no contention is made with respect to a "serious burden" in the Restriction Requirement. As per the MPEP the restriction is not proper. Reconsideration is requested.

While it is not even clear from the Restriction Requirement whether combination/cubcombination is at issue, MPEP Sec. 806.05(d), which requires "Care must be taken to determine if the subcombinations are generically claimed. Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required ." If this be a basis for the Sec. 121 Restriction Requirement, reconsideration is requested.

Similarly, MPEP Sec. 806.05(d) further provides for showing" two-way distinctness" which has not been shown in the Restriction Requirement. The Restriction Requirement is defective for this reason too. If this be a basis for the Sec. 121 Restriction Requirement, reconsideration is requested.

In the Restriction Requirement, no consideration has been show as to whether "the subcombinations are generically claimed" as required by MPEP Sec. 806.05(d), and for this reason too, the Restriction Requirement is defective and, under the pending claims, "should not be required." See the Examiner's note to MPEP Sec. 806.05(d): "Where subcombinations as disclosed and claimed are both (a) species under a claimed genus and (b) related, then the question of restriction must be determined by both the practice applicable to election of species

and the practice applicable to related inventions. If restriction is improper under either practice, it should not be required." If this be a basis for the Sec. 121 Restriction Requirement, reconsideration is requested.

In sum, the Restriction Requirement made out pursuant to Sec. 121 fails to make out a *prima facie* case and is defective for the reasons set forth above. Indeed, the Office Action is so unclear as to the Restriction Requirement that it is respectfully submitted that a fair response cannot be made. The Office Action is improper under 35 U.S.C. Sec. 132 for this reason.

Turn now to the lack of unity contention under the PCT. In the Office Action, the Examiner contends that "Groups I and II lack corresponding technical features because group II does not include the execution of an option on a loan, as required by group I".

In response, the contention is respectfully traversed. Claim 1 of group I does not require "the execution of an option on a loan." Neither group requires the feature that the Examiner contends as distinguishing the groups I and II.

With regard to groups III-VIII, the Examiner acknowledges a common technical feature, but the technical feature elected by the Examiner has not been shown to be the only common technical feature. Thus, lack of unity has not been established in the Office Action.

Further, to the extent that the contentions of Para. 2 are understood, the Examiner appears to be suggesting that the common feature lacks inventive step or novelty.

In response the contention is respectfully traversed. The Examiner's contentions are contradicted by the only search of the claims of record - that in the PCT application. Accordingly, the Examiner's affidavit or declaration, or other evidence, is required – at least to enable Applicant to attempt to square the only search of the claims of record with the Examiner's contrary contentions. The PTO cannot ignore the PCT Written Opinion, presume lack of inventive step or novelty, and based on the contradicted presumption, require restriction.

The Office Action does evidence a proper case of lack of unity of invention.

Further, as to all groups, the requirement is improper. Under the PCT, it is believed that the determination of unity of invention is made on the contents of the claims as interpreted in light of the description and drawings (if any). This has not been done in the instant application, and reconsideration is requested.

Additionally, it is believed that under the PCT, the general inventive concept can be evident indirectly, i.e. the form of the invention claimed takes advantage of, or relies on, the general concept. This has not been shown in the Office Action.

Under the PCT, unity is believed to be considered in the first instance, only in relation to the independent claims. If the independent claims satisfy the requirements of unity of invention and avoid the prior art then no unity problem will arise in relation to any of the dependent claims. Where an independent claim does not avoid the prior art then the inventive link between all the dependent claims must be considered carefully and an objection of lack of unity *a posteriori* (that is, arising only after assessment of the prior art) taken if applicable.

[PCT/GL/ISPE/1 at para 10.06] The Office Action is defective for failing to address the dependent claims in the manner required by the PCT.

Applicant respectfully submits, consistent with the PCT Written Opinion, that there is unity of invention. Unity exists not on the Examiner's selection of one inventive feature, but instead on a general inventive concept under the PCT, as elucidated above. With this in mind, the Examiner's attention is respectfully drawn to certain computer-related operations pertaining to a loan in connection with an option, trigger, lock, or the like, as set forth in the claims, each as a whole.

Otherwise, pursuant to Rule 104, and 35 U.S.C. Sec. 132, the Examiner is required to provide "such information as may be useful in judging the propriety of continuing the

prosecution of his application." In particular, the Examiner is requested to provide information as to the disparity between the PCT view of the cited art and the Examiner's contended view, and the disparity between the PCT's determination of unity of invention and the Examiner's contended view.

In sum, for the reasons set forth above, the Restriction Requirement/Election/Lack of Unity is believed to be improper under both Sec. 121 and under the PCT, and reconsideration is respectfully requested.

APPLICANT CLAIMS SMALL ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235.

Please direct all correspondence to the undersigned at the address given below.

Respectfully submitted,



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